

REMARKS

A. Introduction

Claims 1-26 are pending and under consideration in the application.

In the Office Action of March 13, 2009 ("the Office Action"), claims 1-26 were rejected as obvious.

In response, the rejections are traversed.

Reconsideration and allowance of all the pending claims are requested in view of the following remarks.

B. Rejection under 35 USC §103

Claims 1, and 3-26 have been rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent Publication 2003/0161988 to Hwang and U.S. Patent Publication 2003/0044719 to Katoh. Applicants traverse these rejections for at least the following reasons.

Independent claims 1 and 14 recite: (1) a first lower dielectrics layer; (2) a second lower dielectrics layer; (3) a first upper dielectrics layer; and (4) a second upper dielectrics. However, the Examiner appears to have neglected to address these recited elements, and even if they were addressed, neither Hwang nor Katoh teach or fairly suggest these recitations.

The Office Action merely argues that Katoh teaches "a lower dielectrics layer (2)" and "an upper dielectrics layer (4)." See the Office Action, para. 5. Thus, at best, the Office Action only addresses 2 of the 4 dielectrics layers required by independent claims 1 and 14.

Yet, both Hwang and Katoh are limited to a single lower dielectric layer and a single upper dielectric layer. See Katoh, fig. 1, Katoh, fig. 1. This is not the same as 4 dielectric layers.

As best understood by Applicant, the Examiner acknowledges that neither Katoh nor Hwang have 4 dielectrics layers, but is arguing for the addition of 2 new layers using materials that are simply listed in Katoh, which fails to provide any advantages of using the materials. Such an argument, however, is contrary to proper examination protocol because it is impermissible to argue for the addition of new elements that are neither disclosed nor suggested in art of record. At best, if the Katoh materials were employed in Hwang, the result

would not yield additional upper and lower dielectric layers, as required by independent claims 1 and 14, but would result in a mixture of material.

Further, the motivation to extract the Katoh material for incorporation into Huang is flawed. Katoh merely provides a random listing of materials that *may be used* to form a dielectric layer, i.e., “nitrides such as Si_3N_4 ” and “sulfides such as ZnS,” and states that these material *may be used* “individually or in combination.” Katoh paras. 100 and 101. Katoh provides no further discussion of these materials and, therefore, fails to provide any motivation to select any one of these materials, and especially not a specific combination thereof.

In attempt to provide motivation, the Examiner argues that one would select these materials to “prevent[] chemical reaction of the first compounds of the dielectric layers with the recording layer.” See the Office Action, pg. 4. However, there is no support for this argument and this alleged benefit is not found in any of the references of record. Clearly, the combination of these references is an unmistakable product of impermissible hindsight.

If the Examiner maintains the present grounds of rejection, it is respectfully requested that the Examiner point out with particularity, e.g., by citing reference numerals and/or passages: (1) where all 4 dielectrics layers required by independent claims 1 and 14 are disclosed in the art of record; and (2) a teaching within the art of record that would motivate one to extract the Katoh material for incorporation into Huang. The MPEP states “[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing” and “any such grounds relied on...must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal.” See MPEP §706.07.

In addition to the above deficiencies, the Examiner repeatedly employs Katoh to reject the majority of dependent claims, but fails to provide any motivation to incorporate the Katoh elements into the primary reference, Hwang. For instance, in attempt to reject claims 5 and 18, the Examiner alleges Katoh employs a “phase change recording layer.” See the Office Action, page 4. Further, the Examiner alleges that Katoh teaches specific material percentages and thicknesses in attempt to reject other claims. Still further, in attempt to reject claims 11 and 24, the Examiner alleges that Katoh a light transmissive sheet and an adhesive layer. Notably, the Examiner provides no logic or other articulated reasoning as to why one would be motivated to

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employ this Katoh element into the primary reference, Hwang. Thus, these rejections under U.S.C. 103 are flawed.

Accordingly, Hwang and Katoh, both individually and combination, fail meet all of the limitations recited in claims 1-26. Therefore, the rejections of claims 1-26 under 35 U.S.C. §103(a) are improper, and withdrawal of these rejections and allowance of these claims are earnestly solicited.

C. Conclusion

In view of the foregoing, it is submitted that claims 1-26 are allowable and that the application is in condition for allowance. Notice to that effect is requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,

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